

II. AMENDMENT

1. In the Drawings

Please replace the four drawing sheets containing Figures 2A& 2B (one sheet), 4A, 4B and 4C with the new four drawing sheets attached to the end of this paper. Each new sheet is marked "Replacement Sheet" in the margin.

III. REMARKS

1. Remarks on the Amendment to the Drawings:

The drawing sheet containing Figures 2A and 2B is amended to remove the reference to compound 7 because compound 7, illustrated in Fig. 2B, is not entirely identical to compound 7, illustrated in Fig. 1. In particular, the compound in Fig. 1 is not isotopically enriched and the compound in Fig. 2B is isotopically enriched with ^{15}N .

Drawing sheets containing Figures 4A, 4B and 4C have been amended to increment by 1 the number corresponding with each structure since it has been observed that the number 19 was used for differing structures in both Figure 3B and 4A. By incrementing the numbers in Figures 4A, 4B and 4C, confusion is avoided. Corresponding amendments to the specification are also requested.

2. Remarks on the Amendment to the Specification:

An amendment to various sections of text has been requested to correct clerical errors and to increment several of the numbers corresponding with structures found in the figures. Corrections for various other clerical errors have been requested. For example, it has been observed that the symbol •• was substituted for the Greek character δ which is commonly used to signify chemical shift in ^1H -NMR analysis. Entry of the amendment to the specification is requested.

3. Remarks on the Amendment to the Claims:

Claim 1 has been amended to delete the text "either of" as this seems to be grammatically incorrect. Additionally, "N-methyl piperazine" has been changed to "N-substituted piperazine" so that the preamble is consisted with the claim body. These changes are not made: 1) to narrow the claim scope; or 2) in response to any pending rejection.

Claim 9 was amended to address the insufficient antecedent basis rejection of claim 10 as articulated in paragraph 2 on page 3 of the Office Action. Antecedent basis for this change can be found throughout the application, but in particular at page 8, line 22 to page 9, line 2.

Claims 18-20 are newly added and are intended to permit Applicants to more distinctly claim subject matter for which Applicants seek letters patent. Antecedent basis for these claims can be found throughout the specification but in particular at pages 5-9 of the application as filed.

It is believed that no new matter has been added by entry of any of the requested amendments to the drawings, specification or claims.

4. Formal Matters:

A supplemental information disclosure statement was filed by Applicants on September 20, 2006 (after issuance of the present Office Action). An additional IDS is being submitted with this paper. The Examiner is requested to complete the related PTO Form-1449 for each submission with the next communication from the Office.

5. Response to the Rejections under 35 U.S.C. § 112, second paragraph:

a) *Rejection for use of the term "comprising"*

Claims 1-17 stand rejected under 35 U.S.C. § 112, second paragraph for use of the word "comprising". The rejection appears to assert that it is a *per se* violation of 35 U.S.C. § 112, second paragraph to use the term "comprising" with respect to a composition claim. Applicants respectfully disagree.

While Applicants agree that *Ex parte Gottzein* ("*Gottzein*") and *Ex parte Davis* ("*Davis*") support the premise that "comprising" is an open-ended term, neither holds or suggests that it is improper to use the term "comprising" with respect to claiming a composition of matter.

In support of the position that "comprising" can properly be used in a claim to a composition of matter, Applicants submit Exhibits A-D (attached).

Exhibit A lists results 1-50 of a search of the USPTO Patent Full-Text and Image Database wherein the database was queried for all patents where "comprising" and "composition" could be found in the claims. As can be seen from Exhibit A, a total of 223256 patents satisfy the search criteria, all of which have issued since the decisions in *Gottzein* and *Davis*.

Exhibit B is a printout of result no. 5, which is recently issued US Patent No. 7,139,463 (Issued November 21, 2006) entitled: "**Compositions and Devices for**

Thermooptically Controlled Switching and Filtering". As can be seen on page 3 of 13 of the printout, claim 1 recites: "*A thermooptically active **composition comprising**...* (emphasis added)".

Similarly (but issued more than 30 years ago), Exhibit D, which is result number 223202 (Exhibit C), is a printout of US Patent No. 3,931,085 (Issued January 6, 1976) entitled: "**Synthetic Resin Compositions**". As can be seen on page 2 of 22 of the printout, claim 1 recites: "*A synthetic resin **composition having an alkaline pH comprising**...* (emphasis added)".

In view of the common usage of "comprising" with respect to composition claims, it is respectfully submitted that the rejection is improper and should be withdrawn. Reconsideration and withdrawal of this rejection is therefore earnestly solicited.

b) Rejection for insufficient antecedent basis

Claims 10 and 14 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly having insufficient antecedent basis. Claim 9 has been amended to correct the antecedent basis problem of claim 10.

Regarding claim 14, it is respectfully submitted that claim 1 recites "or a salt thereof". Accordingly, it is believed that claim 14 has proper antecedent basis.

In view of the amendments and remarks, reconsideration and withdrawal of the rejection of claims 10 and 14 is respectfully submitted.

c) Other Applications Owned by Applera Corporation

For the convenience of the Examiner, reference is made to Table 1, below, and the identified copending applications owned by Applera Corporation. The Examiner is invited to review the claims of these applications for consideration of any obviousness type double patenting rejections that he/she may feel is/are appropriate.

Table 1

Title	Serial No.	Filing Date	Status
Mixtures Of Isobarically Labeled Analytes And Fragments Ions Derived Therefrom	10/751,353	05 Jan 2004	Abandoned
Active Esters of N-substituted Piperazine Acetic Acids, Including Isotopically Enriched Versions Thereof	10/751,354	05 Jan 2004	Pending
Isotopically Enriched N-Substituted Piperazine Acetic Acids And Methods For The Preparation Thereof	10/751,387	05 Jan 2004	Pending
Methods And Mixtures Pertaining To Analyte Determination Using Electrophilic Labeling Reagents	10/765,264	27 Jan 2004	Pending
Compositions And Kits Pertaining To Analyte Determination	10/765,267	27 Jan 2004	Allowed
Methods And Mixtures Pertaining To Analyte Determination	10/765,458	27 Jan 2004	Pending
Mixtures Of Isobarically Labeled Analytes And Fragments Ions Derived Therefrom	10/822,639	12 Apr 2004	Allowed
Isobarically Labeled Analytes And Fragment Ions Derived Therefrom	10/852,730	24 May 2004	Pending
Method And Apparatus For De-Convoluting A Convolutted Spectrum	10/916,629	12 Aug 2004	Allowed
Analysis Of Mass Spectral Data In The Quiet Zones	10/999,638	24 Nov 2004	Pending
Preparation Of Biologically Derived Fluids For Biomarker Determination By Mass Spectrometry	11/051,807	04 Feb 2005	Pending
Determination of Analyte Characteristics Based Upon Affinity Binding Properties	11/069,277	01 Mar 2005	Pending
Isobaric-Coded Mass Tags for Quantitative Protein Analyses with Tandem MS	11/179,060	11 Jul 2005	Pending
Methods, Compositions and Kits Pertaining To Analyte Determination	11/319,685	28 Dec 2005	Pending
Mass Tags for Quantitative Analysis	11/355,904	15 Feb 2006	Pending

IV. SUMMARY

It is believed that this response addresses all issues set forth in the present Office Action and the application is in ready condition for allowance. In consideration of the preceding amendments and remarks, Applicants hereby respectfully request the issuance of a Notice of Allowance by The Office.

V. INTERVIEW

If the Examiner believes a telephonic or personal interview would advance the prosecution of the subject application, the Examiner is invited to contact attorney Gildea during business hours at the telephone or facsimile numbers listed below.

VI. FEES

A supplemental Information Disclosure Statement (IDS) is being filed with this submission. Authorization to make an appropriate charge to Deposit Account No. 01-2213 accompanies said IDS. Since the amendment set forth above does not increase the claim count beyond 3 independent claims and 20 total claims, no fees are believed to be due to The Office for consideration of this paper. If however, The Office determines that any fee is properly due for its consideration of this paper, authorization is hereby granted to charge any required fee associated with the filing or proper consideration of this paper to Deposit Account 01-2213 (Invoice No. BP0308-US). **A duplicate of this page is included with this submission.**

VII. CORRESPONDENCE/CUSTOMER NUMBER

Please send all correspondence pertaining to this document to:

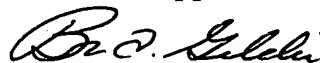
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IF NOT ALREADY DONE, PLEASE ASSOCIATE THIS CASE WITH CUSTOMER NUMBER

23544

Respectfully submitted
on behalf of Applicants,



Brian D. Gildea, Esq.; Reg. No. 39,995

Nov. 28, 2006

Date

Figure 2A

Scheme A For The Synthesis Of N-Methyl Piperazine Acetic Acids

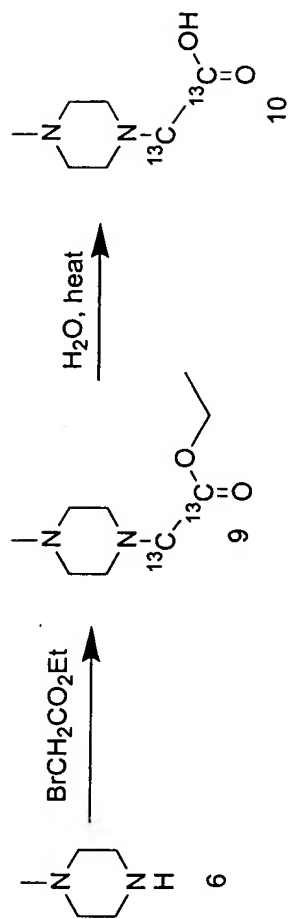


Figure 2B

Scheme B For The Synthesis Of N-Methyl Piperazine Acetic Acids

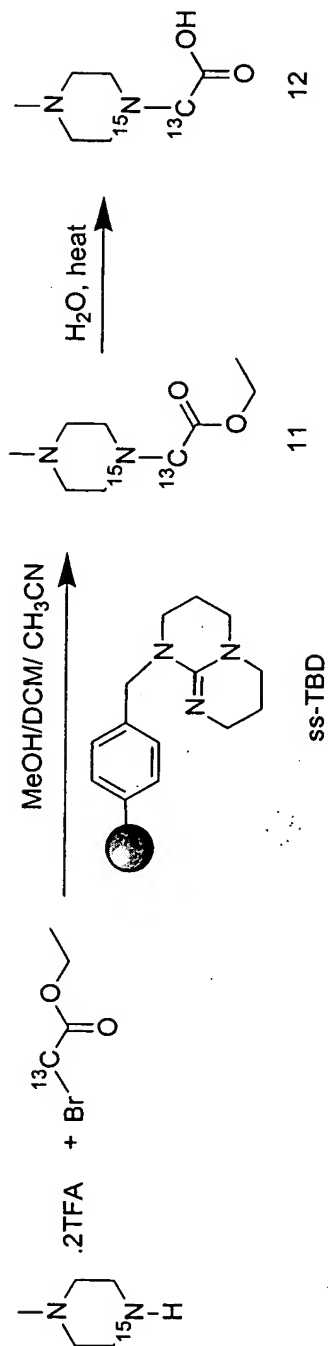


Figure 4A
Scheme A For The Synthesis Of Various Active Esters Of N-Methyl Piperazine
Via Imidazolid Formation

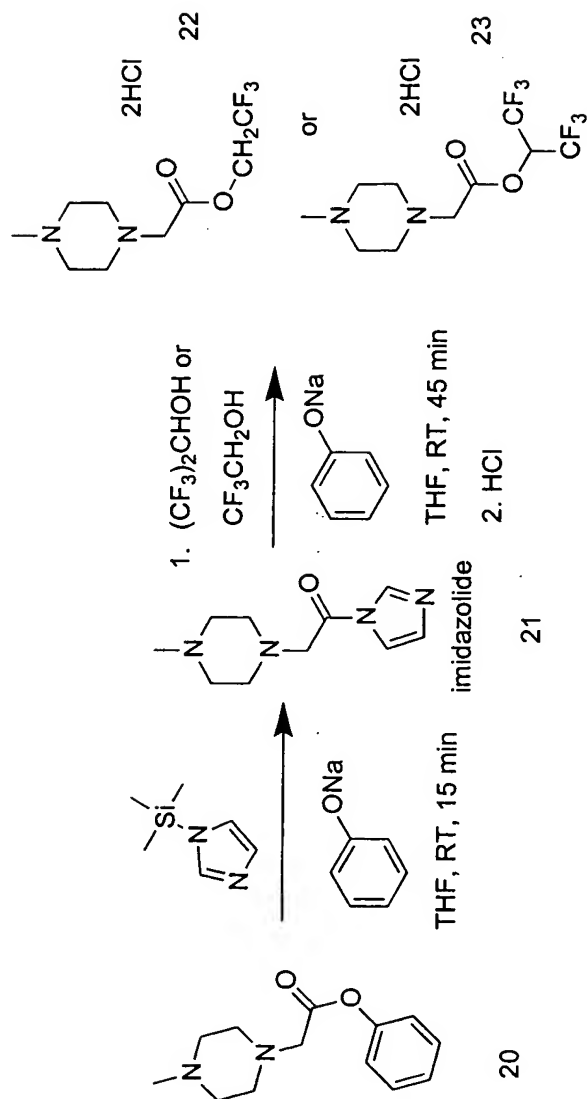


Figure 4B

Scheme B For The Synthesis Of Various Active Esters Of N-Methyl Piperazine
Via Oxallyl Chloride

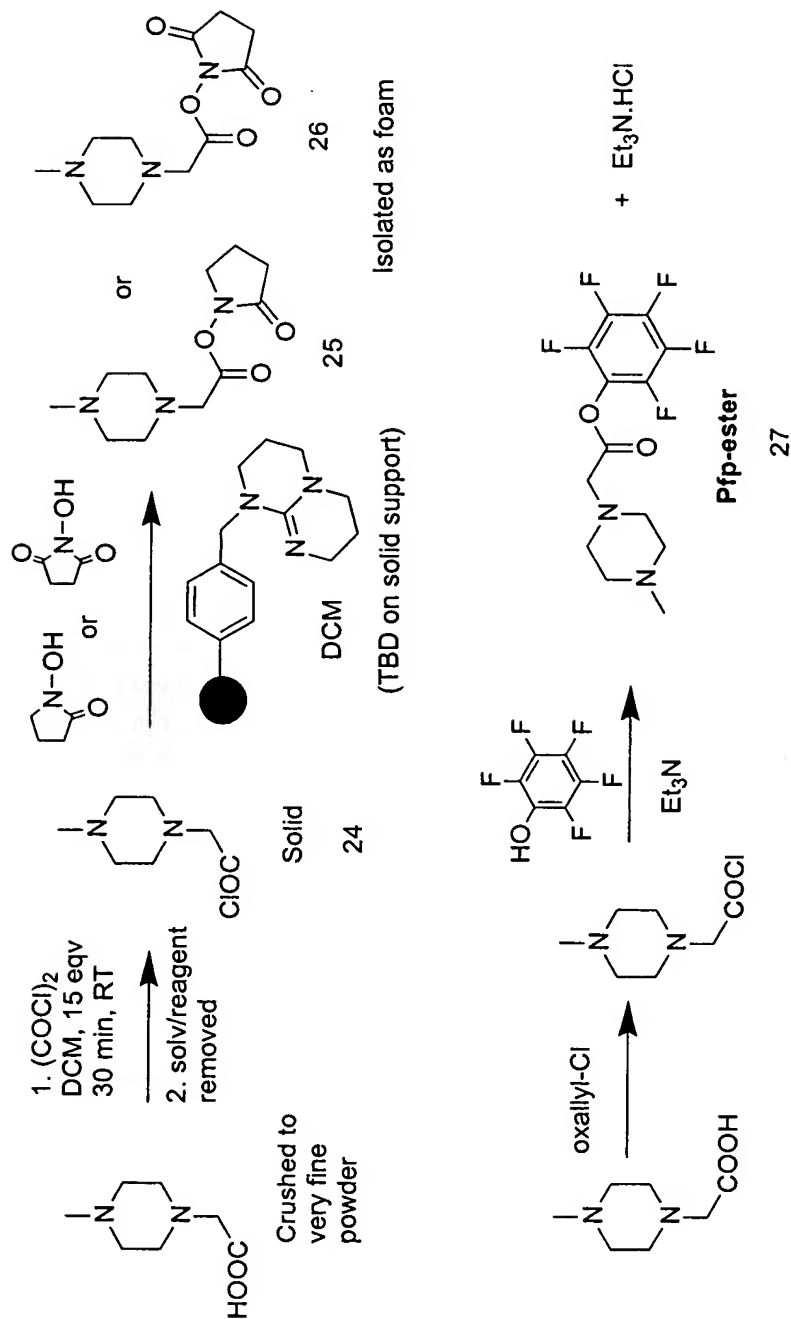


Figure 4C

Scheme C For The Synthesis Of Various Active Esters Of N-Methyl Piperazine
Via Trifluoroacetate Ester

